

ESTTA Tracking number: **ESTTA550550**

Filing date: **07/25/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91210776
Party	Defendant Oak73, LLC
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Date	07/25/2013
Attachments	Applicant's Opposition To Opposer's Motion To Amend Notice of Opposition July 25 2013.PDF(223787 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of App. Serial No.: 85/776,034  
Mark: OAK73

AUDEMARS PIGUET HOLDINGS S.A.	)	
	)	
<i>Opposer,</i>	)	
	)	
v.	)	
	)	
OAK73, LLC	)	
	)	
<i>Applicant.</i>	)	
	)	

Opposition No. 91210776

**APPLICANT’S OPPOSITION TO OPPOSER’S MOTION TO AMEND NOTICE OF  
OPPOSITION**

OAK73, LLC (hereinafter referred to as “Applicant”), by and through its counsel, hereby opposes the Motion to Amend Notice of Opposition filed by AUDEMARS PIGUET HOLDINGS S.A. (hereinafter referred to as “Opposer”) as follows:

**I. Opposer’s Amended Claim of Fame Among the General Consuming Public  
Conflicts with Its Original Claim of Niche Fame and Should be Rejected.**

Pleadings generally may be amended where the proposed amendment does not violate settled law or prejudice the opposing party. T.B.M.P. 507.02. However, where the proposed amendment is futile, it must be disallowed. *Leatherwood Scopes Int’l, Inc. v. James M. Leatherwood*, 63 U.S.P.Q.2D (BNA) 1699 (T.T.A.B. 2002); T.B.M.P. 507.02. An amendment is futile where it is legally insufficient, meaning it would not survive a motion to dismiss under F.R.C.P. 12(b)(6). See 3 JAMES WM. MOORE ET AL., MOORE’S FEDERAL PRACTICE ¶15.15(3) (3d. ed. 1999); *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d (BNA) 1503 (T.T.A.B. 1993). In assessing whether a pleading is sufficient for the purposes of a motion to dismiss, “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory

statements, do not suffice.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Rather, a party must allege sufficient facts to “nudge[its] claims across the line from conceivable to plausible.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007); *Iqbal*, 556 U.S. at 680.

In order to prevail on a dilution claim under Section 43(c) of the Lanham Act, a party must show that, at the time of filing its opposition, its mark ranks among a “select class of marks – those marks with such powerful consumer associations” that they rise to the level of a “household name.” *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002, 1012 (9th Cir. 2004); 15 U.S.C. § 1125(c)(2)(A) (“a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner”). Mere “niche fame,” or fame within a limited market or industry, is inadequate. *Top Tobacco, L.P. v. North Atl. Operating Co., Inc.*, 509 F.3d 380 (7th Cir. 2007) (2006 TDRA clarified that niche fame is inadequate to support a federal dilution claim).

In Opposer’s original Notice of Opposition, Opposer claimed that its mark, ROYAL OAK, had achieved niche fame by alleging that the mark is “famous and distinctive *in the relevant industry and trade*, and with consumers.” (emphasis added). Opposer’s initial allegations concerning the scope of public recognition of its mark made clear that Opposer relied on the mark’s “niche fame.” Nowhere in the original Notice of Opposition did Opposer assert that the ROYAL OAK mark possessed the required degree of fame to be protectable under Section 43(c) of the Lanham Act. If Opposer believed ROYAL OAK to be a broadly famous mark or if it was aware of facts supportive of such a claim, it could have pled those allegations from the outset. But it did not. Opposer’s original pleading said nothing about the mark’s degree of recognition among the general consuming public of the United States.

Applicant moved to dismiss Opposer's dilution claim because the allegations made in support of that claim concerning "niche fame" caused it to fail as a matter of law. Only when confronted with the legal insufficiency of "niche fame" for the purposes of a dilution claim (see Motion to Dismiss at ¶ 8) did Opposer seek to amend its allegations concerning the fame of its mark. Statements in pleadings are binding judicial admissions. *McAfee v. United States*, 832 F.2d 152, n.\* (Fed. Cir. 1987) (citing 4 J. WIGMORE, EVIDENCE §1064, at 67 (Chadbourn rev. 1972)). Opposer's attempt to salvage its dilution claim must be disallowed where the new allegations in the proposed amended pleading contradict the very allegations that doomed Opposer's initial claim. Amended allegations which conflict with and seek to evade Opposer's judicial admissions are futile and fail to meet the pleading standards set forth in *Iqbal* and *Twombly*.

**II. Opposer's Proposed Amendment Fails to Cure the Deficiencies in the Original Pleading.**

Even if Opposer were permitted to amend its pleading in a manner that conflicts with the original, Opposer's proposed amendments still do not allege that ROYAL OAK is among the class of marks that may be considered a "household name" *Nissan*, 378 F.3d at 1012. The proposed amended Notice still fails to allege facts sufficient to establish that ROYAL OAK is among the elite class of marks described in *Nissan*. 378 F.3d at 1012. Because even with the proposed amendments, Opposer has failed to allege facts that would make its dilution claim plausible, the amendment is futile and should be denied.

Opposer's proposed amendments include only conclusory statements of law and facts that are irrelevant to the fame of its mark. For example, one of the new allegations contained in the proposed amended notice states: "Opposer first introduced the Royal Oak watch in the early 1970's. Due to its specific and unique design, the Royal Oak became an instant hit, and in the

subsequent 40 years has become one of the most famous watches in the world.” [Proposed] Am. Notice of Opp’n. at ¶8. That Opposer’s watches were introduced 40 years ago has no bearing on whether ROYAL OAK *currently* ranks among the elite class of marks that may be considered household names. Moreover, the watches’ allegedly unique design is not relevant to the ROYAL OAK word mark’s fame, or lack thereof. And, importantly, Opposer’s allegation regarding current *worldwide* fame again fails to allege widespread recognition among the general consuming public of the United States, as required by the statute.

Opposer also states that “the New York Times . . . listed Royal Oak as one of the few ‘truly classic watches’ and a ‘timeless icon.’” *Id.* At most, this statement permits the inference that ROYAL OAK is known among connoisseurs of expensive watches or that Royal Oak watches are of high quality. Again, however, Opposer does not allege any fact from which one could conclude that its mark is a household name or widely recognized among U.S. consumers generally.

Finally, Opposer offers statements in its proposed amended notice that essentially list, in an entirely conclusory fashion, the requirements given in 15 U.S.C. 1125(c)(2)(A)(i)-(iii), stating: “Goods offered under Opposer’s Marks have been extensively advertised, promoted, and publicized by Opposer in the United States and have achieved significant sale success. The public has come to recognize Opposer’s Marks as distinctive of its goods and as an indication of source of such goods.” [Proposed] Am. Notice of Opp’n. at ¶9. Merely parroting the statutory language is inadequate under the pleading standards set forth in *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Even if Opposer’s proposed amended pleading did not contradict Opposer’s initial Notice of Opposition, the allegations offered as an attempt to cure the defective Notice are unsupportive of a dilution claim as a matter of law.

### III. Conclusion

Because Opposer's proposed amended Notice of Opposition contradicts its original pleading with regard to the degree of fame of the asserted ROYAL OAK mark, it must be rejected. Moreover, even if Opposer had not judicially admitted that its mark enjoys only niche fame, at most, Opposer's proposed amended Notice still does not adequately allege dilution as a basis for opposition. Accordingly, Opposer's motion to amend its Notice of Opposition should be denied and Applicant's prior motion to dismiss dilution as a basis for Opposer's opposition should be granted.

Respectfully submitted,

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Dated: Chicago, IL  
July 25, 2013

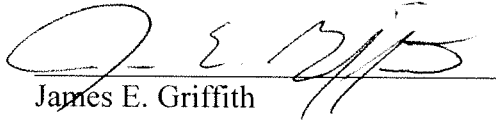
# **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **APPLICANT'S  
OPPOSITION TO OPPOSER'S MOTION TO AMEND NOTICE OF OPPOSITION** was  
sent by first class mail to:

John A. Galbreath  
Galbreath Law Offices  
2516 Chestnut Woods Ct.  
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attorney for Opposer, this 25th day of July, 2013.

Dated: July 25, 2013

  
James E. Griffith